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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,971	12/09/2003	Junichi Asoh	JP920020248US1	3670

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EXAMINER	
CERVETTI, DAVID GARCIA	
ART UNIT	**PAPER NUMBER**
2136	

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05/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/730,971	ASOH ET AL.	
	Examiner	Art Unit	
	David G. Cervetti	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/20/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-15 are pending and have been examined.

Specification

2. The disclosure is objected to because of the following informalities: "USB" (page 2), "CPU" (page 7), "RC4, RC5, AES" (page 10), etc. These terms have not been defined. Appropriate correction is required.

3. This is not intended to be a complete list of such informalities.

Claim Objections

4. Claims 5 and 9 are objected to because of the following informalities: "PCMCIA" must be spelled out. Appropriate correction is required.

5. Claims 6 and 10 are objected to because of the following informalities: "USB" must be spelled out. Appropriate correction is required.

Double Patenting

6. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/730,968. Although the conflicting claims are not identical, they are not patentably distinct from each other because **"acceptance means for accepting an ejection request to the external storage device; and encryption means for encrypting a predetermined data file stored in the external storage device if the ejection request has been accepted by the acceptance means"** (claim 1, instant application) is analogous to "**accepting an operation by a user and issuing an ejection request to the external storage device connected to the computer in**

accordance with specifications specifying that software control should be performed, including processing to stop access to the device, when ejection is performed; and reading and encrypting a predetermined data file stored in the external storage device and storing the data file in the external storage device, if the ejection request has been issued" (claim 1, copending application).

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-12 of copending Application No. **10/730,968** contain every element of claims 1-15 of the instant application and thus anticipate the claims of the instant application. Claims 1-15 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

9. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species with that genus). "ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

10. "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic claim. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1-3, 5-7, and 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (US Patent 6,529,992, hereinafter Thomas).

Regarding claim 1, Thomas teaches

- an information processor comprising: a computer; and an external storage device detachably connected via a connector provided for the computer **(abstract, col. 7)**; the computer comprising; acceptance means for accepting an ejection request to the external storage device **(abstract, col. 7)**; and
- encryption means for encrypting a predetermined data file stored in the external storage device if the ejection request has been accepted by the acceptance means **(col. 9, lines 12-60)**.

Regarding claim 7, Thomas teaches

- an information processor comprising: a computer; and an external storage device detachably connected via a connector provided for the computer **(abstract, col. 7)**;
- the computer comprising; event detection means for detecting a mounting event issued when the external storage device is connected to the connector **(abstract, col. 7)**;
- encrypted file detection means for checking whether or not an encrypted data file is stored in the external storage device which has been detected to be mounted by the event detection means **(col. 9, lines 12-60)**; and

- decryption means for decrypting the encrypted data file detected by the encrypted file detection means using a preset passphrase **(col. 9, lines 12-60)**.

Regarding claim 11, Thomas teaches

- an encryption processing system for providing encryption processing for a data file stored in an external storage device connected to a computer; the encryption processing system comprising **(col. 7, lines 5-67)**:
- acceptance means for accepting an ejection request to the external storage device connected to the computer in accordance with specifications specifying that software control should be performed, including processing to stop access to the device **(abstract, col. 9, lines 12-60)**,
- when ejection is performed; and encryption means for encrypting a predetermined data file stored in the external storage device if the ejection request has been accepted by the acceptance means **(col. 9, lines 12-60)**.

Regarding claim 2, Thomas teaches device stopping means for stopping access to the external storage device for which encryption of the predetermined data file by the encryption means has been completed **(abstract, col. 9, lines 12-60)**.

Regarding claims 3 and 13, Thomas teaches passphrase managing means for accepting and managing input of a passphrase used for encryption by the encryption means **(col. 7, lines 48-67, col. 8, lines 1-26)**.

Regarding claims 5 and 9, Thomas teaches wherein the connector is a PCMCIA connector **(col. 4, lines 44-67, col. 5, lines 1-12)**.

Regarding claims 6 and 10, Thomas teaches wherein the connector is a USB connector **(col. 4, lines 44-67, col. 5, lines 1-12)**.

Regarding claim 12, Thomas teaches decryption means for detecting that the external storage device is connected to the computer and decrypting the encrypted data file stored in the external storage device **(abstract, col. 9, lines 12-60)**.

Regarding claims 14 and 15, Thomas teaches wherein said system is installed in a retail environment / networked within a computer network **(col. 6, lines 5-67)**.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, and further in view of Admission.

Regarding claim 8, Thomas teaches wherein the decryption means requires input of a passphrase **(col. 7, lines 49-67)** but is moot regarding requiring input when the preset passphrase does not decrypt the file. However, Examiner takes Official Notice that requiring another input when a preset information does not perform as intended (i.e. prompting for a password when a saved password has expired or has been changed) was conventional and well known, and further, in view of Applicant's admission that prompting users to enter passphrases was the state of the art at the time the invention was made **(specification, Description of the Related Art, page 3)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to require input of a passphrase when a preset one does not decrypt the file since Examiner takes Official Notice and it has been admitted that it was conventional and well known.

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, and further in view of Ehrsam et al. (US Patent 4,386,234, hereinafter Ehrsam).

Regarding claim 4, Thomas does not expressly disclose wherein the encryption means is provided with multiple encryption engines used for encryption of the predetermined data file and dynamically changes the encryption engines to use them. However, Ehrsam teaches wherein the encryption means is provided with multiple encryption engines used for encryption of the predetermined data file and dynamically changes the encryption engines to use them **(col. 8, lines 15-55)**. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dynamically change the encryption engines. One of ordinary skill in the art would have been motivated to perform such a modification to make it more difficult to perform a brute force attack **(Ehrsam, col. 2, "moving target")**.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

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5/26/07